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Atty. Dkt. No. 041673-2053

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tuszynski, Mark H.
Title: METHODS FOR THERAPEUTIC
USE OF BRAIN DERIVED
NEUROTROPHIC FACTOR IN
THE ENTORRHINAL CORTEX
Appl. No.: 10/039,078
Filing Date: 12/31/2001
Examiner: Anne Marie Falk
Art Unit: 1632

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| CERTIFICATE OF FACSIMILE TRANSMISSION I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Alexandria, Virginia on the date below. Germaine Sarda (Printed Name) <i>Germaine Sarda</i> (Signature) January 31, 2005 (Date of Deposit) |
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RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the restriction requirement as between claims of Group I and Group II as set forth in the Office Action mailed December 29, 2004, Applicant hereby elects Group I, Claims 6 through 8, for examination, without traverse.

The Examiner has required restriction between Claims 6-8 (Group I), drawn to a method for delivery of a therapeutic nervous system growth factor into the brain via a recombinant expression vector, and unspecified claims (Group II), relating to delivery of the nervous system growth factor as a protein. Linking claims between the groups are identified as claims 1-5 and 9-16, which are all of the claims pending in the application not placed within Group I. Such claims will be examined in this application with respect to the Group II invention on allowance thereof with respect to the Group I invention.

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A further restriction requirement is maintained with respect to the species of nervous system growth factors encompassed by the pending claims, including BDNF, NT-4/5 and NT-3. Other nervous system growth factors are also encompassed within the scope of the claims; e.g., NGF (see, Specification at page 9, lines 11-21). In particular, all claims excepting claims 3 through 5 extend to growth factors in addition to BDNF, NT-4/5 and NT-3. By Preliminary Amendment submitted herewith, Claim 17 is added to be directed specifically to use of NGF in the invention. In view of the restatement of this restriction requirement, Applicant withdraws his previous response thereto, and provisionally elects NGF as the species of nervous system growth factor for examination, with traverse.

With respect to the appropriateness of the requirement for restriction, Applicant respectfully draws the Examiner's attention to the history of prosecution of claims of comparable scope in several related applications filed by the same inventor and assignee; i.e., Serial Numbers 09/060,543; 09/621,074; 09/730,790; 10/748,337; and 10/032,952. All of these applications include claims, many of which have been allowed and issued, which extend to methods for delivery of nervous system growth factors including, without limitation, NGF, NT-4/5, NT-3, BDNF and GDNF. No requirement for an election between or among species of the species of nervous system growth factors or expression vectors encompassed by the scope of the parent claims was deemed necessary or made in any of the related applications.

As such, the interests of consistent and compact prosecution are best served in the present application by examining its claims under the same circumstances; i.e., without restriction between or among species of nervous system growth factors useful in the methods of the invention. For that reason, Applicant respectfully traverses the present restriction requirement.

With respect to Applicant's provisional election of NGF as a species, Applicant confirms that generic claims may later be allowed that encompass more than one such species. As such, in addition to being made subject to traverse, the election made herein is also without prejudice to


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the granting of claims which encompass more than the single species elected for examination purposes.

On receipt of this response to the outstanding restriction requirement, favorable action on the merits of the claims is respectfully requested.

Otherwise, it is respectfully requested that the restriction requirement as to species of nervous system growth factors be withdrawn and, in view of Applicant's election of the claims of Group I (relating to gene therapy) for examination, that each of Claims 6-8 and linking claims 1-5 and 9-16 (with respect to the elected invention of Group I), and newly added Claim 17, be examined.

Respectfully submitted,

Date January 31, 2005

By _____

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